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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,523	09/11/2006	Naohiko Uchiumi	279036US0PCT	6220

22850 7590 11/03/2008  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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11/03/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/551,523	<b>Applicant(s)</b> UCHIUMI ET AL.	
	<b>Examiner</b> Roberto Rábago	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 and 14 is/are allowed.
- 6) ☒ Claim(s) 1,8-11,13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. Claims 1, 8, 10, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiwara et al. (US 6,472,470).

The reference discloses in Comparative Example 12 a saponified ethylene-vinyl acetate copolymer having the claimed level of ethylene, lactone and carboxyl groups, polymerized at 60°C for 4 hours until the conversion of vinyl acetate (i.e., polymerization rate with respect to vinyl ester) was 30%. The reference does not appear to have reported the intrinsic viscosity; however, the claimed value would appear to be inherent because applicants have claimed a broad scope of conventional intrinsic viscosities expected for copolymers of the type shown in the reference. The burden of proof is shifted to applicants to show that the cited example fails to include a viscosity within the claimed range.

2. Claims 1, 10 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Katayama et al. (US 6,552,123).

The reference discloses in Comparative Example 7 a saponified ethylene-vinyl acetate copolymer having the claimed level of ethylene, lactone, carboxyl groups and sodium ion. The reference does not appear to have reported the intrinsic viscosity; however, the claimed value would appear to be inherent because applicants have claimed a broad scope of conventional intrinsic viscosities expected for copolymers of

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the type shown in the reference. The burden of proof is shifted to applicants to show that the cited example fails to include a viscosity within the claimed range.

3. Applicant's arguments filed 7/14/2008 have been fully considered but they are not persuasive. Applicants' traversal consists of the statement that the cited "patents do not disclose or suggest the presence of functional groups at the copolymer terminals." However, the claims require groups (I) and (II) at copolymer terminals to be any value less than or equal to 0.12 mole percent; this range includes zero mole percent, and therefore the claims do not require any of groups (I) and (II) to be at the polymer terminals. The applied reference examples clearly have the required terminal content because the total amount of lactone rings and carboxyl groups in each applied reference example is less than 0.12 mole %, and therefore said examples necessarily are within the range of such groups at terminal positions.

4. Claims 1, 8-11, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Yanai et al. (US 5,352,750).

The reference discloses in the working examples numerous embodiments of saponified ethylene-vinyl acetate copolymer forming an EVOH copolymer. Example 9 includes the required ethylene content, viscosity, polymerization rate, time and temperature of claims 1, 8-11, 15 and 16. Example 2-3 further discloses the required vinyl ester ratio of claim 11. The reference has not reported the percentage of terminal carboxylic acid and lactone content; however, the record includes no clear basis to

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conclude that the reference fails to meet these features. The burden of proof is shifted to applicants to show otherwise.

5. Claims 12 and 14 are allowed over the prior art currently of record.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rábago/  
Primary Examiner  
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October 26, 2008